



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/585,637 | 07/11/2006 | Masato Kaneko | 292225US0PCT | 8528 |
| 22850 | 7590 | 09/05/2008 | EXAMINER | |
| OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | OLADAPO, TAIWO | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1797 | |
| | | | NOTIFICATION DATE | DELIVERY MODE |
| | | | 09/05/2008 | ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/585,637 | Applicant(s) KANEKO, MASATO | |
| | Examiner TAIWO OLADAPO | Art Unit 1797 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/11/2006; 10/06/2006</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

1. Claim 4 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only and cannot depend from any other multiple dependent claim. See MPEP § 608.01(n).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

Art Unit: 1797

2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1, 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada Tahei (JP 10-279979)
6. In regards to claims 1, 2, Tahei teaches a lubricating oil composition comprising lubricating base oil having a kinematic viscosity of from 2 to 40 mm²/s at 40°C which overlaps the range in claim 1 (abstract).

In the case where the claimed ranges “overlap or lie inside ranges disclosed by the prior art” a prima facie case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

Tahei teaches that the lubricating oil composition contains calcium or barium sulfonate which serves as rust proofer or rust preventing agent in the amount of from 2 to 10 wt. % of the lubricant which encompasses the limitations in claims 1, 2.

Tahei teaches the composition as claimed which provides the necessary amount required for rust prevention of metal surfaces during a sizing process as in the claimed invention. Since the claim is drawn to a composition, it does not depend on the process of sizing for completeness.

A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v.*

Art Unit: 1797

Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Since the composition comprises every element of the claimed invention, all limitations are met.

7. Claims 3, 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada Tahei (JP 10-279979) in view of Deckman et al. (US 2004/0038833)

8. In regards to claim 3, Tahei teaches a lubricating oil composition comprising. Tahei teaches that the composition can comprise additives such as metal deactivators, but does not particularly teach a thiadiazole compound is present [0008].

Deckman teaches a lubricating oil composition with improved wear performance comprising rust inhibitors similar to the composition of Tahei [0085]. Deckman teaches that the lubricant can contain thiadizoles which are used as corrosion inhibitors to prevent degradation of metallic parts. Deckman teaches that thiadizoles are present in an encompassing range of from 0.01 to 5 wt. % in the composition as in range of the claim 3, and thus will intrinsically serve as a metal deactivator.

It would have been obvious for one of ordinary skill in the art at the time of the invention to use the thiadizole corrosion inhibitors of Deckman in the lubricating composition of Tahei in order to prevent degradation of the metal surfaces.

9. In regards to claim 4, Tahei and Deckman combined teach the lubricating oil composition. Deckman teaches the lubricant contains antioxidants in an overlapping range of from 0.01 to 5 wt. % [Deckman, 0093]. In the case where the claimed ranges “overlap or lie inside ranges disclosed by the prior art” a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

Art Unit: 1797

10. Claims 3, 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada Tahei (JP 10-279979) in view of Cahoon et al. (US 5,484,542)

11. In regards to claim 3, Tahei teaches a lubricating oil composition comprising. Tahei teaches that the composition can comprise additives such as metal deactivators, but does not particularly teach a thiadiazole compound is present [0008].

Cahoon teaches a lubricating composition for metal working similar to the invention of Tahei (column 78 lines 63 – 66; column 79 lines 23 – 28). Cahoon teaches that the lubricant contains metal deactivators such as preferably benzotriazole (column 81 lines 4 – 25). Cahoon teaches that metal deactivators are present at preferably from 0.05% and up to 2% which encompasses the claimed range.

It would have been obvious for one of ordinary skill in the art at the time of the invention to use benzotriazole metal deactivators which Cahoon teaches is suitable for working fluids in the working fluid composition of Tahei.

12. In regards to claim 4, Tahei and Cahoon combined teach the composition. Cahoon teaches that the composition can comprise antioxidant compound of for example 6.6 % of the composition with encompasses the range in the claim (column 99 lines 10 – 15).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAIWO OLADAPO whose telephone number is (571)270-3723. The examiner can normally be reached on 8:00 - 4:30.

Art Unit: 1797

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571)272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TO

/Glenn A Caldarola/
Acting SPE of Art Unit 1797